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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181621
Party	Plaintiff StonCor Group, Inc.
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Attachments	STONCOR REPLY TO LES PIERRES OPPOSITION TO MOTION TO STRIKE.pdf (8 pages)(91195 bytes)

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

StonCor Group, Inc.	:	
	:	
Opposer	:	
v.	:	Opposition 91181621
	:	
	:	Application 76/650,832
	:	
Les Pierres Stonedge, Inc.	:	Mark: STONEDGE
	:	
Applicant	:	

STONCOR'S REPLY TO LES PIERRES' OPPOSITION TO STONCOR'S MOTION TO STRIKE MATERIALS ATTACHED TO LES PIERRES' BRIEF

Applicant, Les Pierres Stonedge, Inc. ("Les Pierres"), after declining to present any evidence during its testimony period, is attempting to blindside Opposer, StonCor Group, Inc. ("StonCor") by untimely requesting exercise of judicial notice of documentary evidence important to Les Pierres' case. This is impermissibly violates 37 C.F.R. 2.122(a). The materials attached to Les Pierres' Brief are inadmissible and should be stricken.

In its opposition to StonCor's Motion to Strike, Les Pierres cites T.B.M.P. 704.12(b), providing that "Judicial notice may be taken at any stage of a Board proceeding…" as Les Pierres' authority for seeking judicial notice.[1] The T.B.M.P. is not binding, as stated plainly in the T.B.M.P. introduction: "The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board, its reviewing tribunals, the Director, or the USPTO."[2] Further, 2.122(a) of Title 37 of the Code of Federal Regulations provides that, "The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of

[1] Pg. 2, Les Pierres' opposition to StonCor's motion to strike.
[2] TBMP, "Introduction." (*citing In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989)).

Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations."

The Code of Federal Regulations requires compliance with specific rules during limited time periods in order to have printed publications accepted into evidence:

> Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication of official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) of the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. **The notice of reliance shall be filed during the testimony period of the party that files the notice** (emphasis supplied).[3]

The T.B.M.P., on which Les Pierres relies, states in section 704.12(b):

> The Board will take judicial notice of a relevant fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), if a party (1) requests that the Board do so, and (2) supplies the necessary information. The request **should be made during the requesting party's testimony period**, by notice of reliance and accompanied by the necessary information.

As between the T.B.M.P. and the Code of Federal Regulations, it is fundamental that the Code of Federal Regulations takes precedence and, where conflict exists, trumps the T.B.M.P..

In its brief, Les Pierres requests that the Board take judicial notice of four different dictionary entries, attaching the proffered definitions as exhibits.[4] Les Pierres' requests are improper, because Les Pierres did not make any request during its testimony period to have the

[3] 37 C.F.R. § 2.122.

Board take judicial notice of these materials, nor did Les Pierres submit a notice of reliance. Les Pierres seeks to manipulate the rules by improperly waiting to introduce these materials until long after Les Pierres' testimony period, while still insisting that StonCor is not entitled to submit any rebuttal evidence because Les Pierres presented no evidence during Les Pierres' testimony period.

In the attachments to its brief, Les Pierres proffers obviously carefully selected portions culled from the definitions for "stone" and "floor" found in *Webster's II New Riverside University Dictionary* and in *The Oxford English Dictionary, Second Edition, Volume V* respectively. Les Pierres requests the Board to take judicial notice of only selected portions of a few of the numerous definitions provided for "stone" and "floor" in these works.[5] Les Pierres also requests the Board to take judicial notice of two definitions of the term "decorative stone", as found in an online dictionary.[6]

While Les Pierres argues both in its opposition to StonCor's motion and in Les Pierres' brief that a tribunal may take judicial notice of a dictionary definition, the law is that a court, or this Board, may only do so when the definition is found in a recognized authority.[7] The Board should not accept "Answers.com," (the source of the "decorative stone" definition proffered by Les Pierres) as a "recognized authority". While Les Pierres cites *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, for the proposition that online definitions taken from print publications may be judicially noticed, the decision in *Syngenta Crop Prot.* makes it clear that such definitions must be "of the type that are not subject to reasonable dispute in that they are capable of accurate and

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[4] Pp. 10 n.3, 11 n.5, 15 n. 6, Exhibits A-C; Les Pierres' Brief.
[5] P. 10 n.3, Exhibit A; Les Pierres' Brief; Pg. 11, n.5, Exhibit B; Les Pierres' Brief.
[6] Pg. 15, n.6; Les Pierres' Brief.
[7] *Hancock v. American Steel & Wire Co.*, 40 C.C.P.A. 931, 934 (C.C.P.A. 1953) (Holding that a court may refer to "standard dictionaries or other recognized authorities").

ready determination by resort to sources whose accuracy cannot be reasonably questioned".[8] In *Syngenta*, the Board chose to take judicial notice only of proffered online definitions that were "consistent with those in a more traditional reference source."[9] Les Pierres made no such showing. It would be wrong for this Board to take judicial notice of the materials attached to Les Pierres brief, providing Les Pierres definition of "decorative stone" at any point in this proceeding, and would be particularly prejudicial to StonCor now, when judicial notice of any evidence is too late.[10]

In addition to using an unauthoritative source for the proffered definition of "decorative stone", Les Pierres' offers an irrelevant red herring: Les Pierres alleges the proffered definitions show that the formative of StonCor's family of marks is merely descriptive.[11] Whether or not true of the formative, that contention is irrelevant as respecting StonCor's marks. All of StonCor's asserted marks are registered and incontestable[12], have therefore conclusively acquired trademark status[13], and cannot be stripped of their incontestable status by denigration as having an allegedly descriptive formative. It would be highly inequitable for the Board to take judicial notice of anything, including Les Pierres' proffered definitions, at this late stage, with Les Pierres having failed to submit a notice of reliance regarding the requested materials during Les Pierres' testimony period, as required by the Code of Federal Regulations.

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[8] *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112 (T.T.A.B. 2009).
[9] *Syngenta, supra.* (Noting that the Board was not taking judicial notice of an additional definition deemed not to fit this requirement).
[10] Les Pierres attached print-outs from Amazon.com for the *Dictionary of Architecture and Construction* and the *Sci-Tech Dictionary*, urging that the definitions supplied by the "Answers.com" website can be found in those materials. (Pg. 15, Exhibit C; Les Pierres' Brief). The "information about these publications," Les Pierres attached to its Brief does not even provide the names of the entities purportedly publishing the "dictionaries". Without presenting the names of the publishers, Les Pierres cannot argue that this information is "capable of accurate and ready determination by resort to sources whose accuracy cannot be reasonably questioned" or that this information and those definitions are consistent with those found in a more traditional reference source, as required by *Syngenta.*
[11] Pg. 11, ln. 15-17; Les Pierres' Brief.
[12] 15 USC 1065

The need for filing a notice of reliance as a condition precedent to a request for judicial notice is underscored in *Litton Business Systems, Inc. v. J.G. Furniture Co.*, 190 U.S.P.Q. 431 (T.T.A.B. 1976),[14] discussed at length in StonCor's reply brief. In *Litton*, the Board dismissed a petition for cancellation because the petitioner failed to present any evidence during its testimony period in support of its position that respondent's mark was merely descriptive.[15] The petitioner argued that it was appropriate for the Board to take judicial notice of a dictionary definition of a term used in the respondent's mark, with the dictionary definition supporting the petitioner's argument that the term was merely descriptive.[16] The Board found that "petitioner's request for judicial notice of critical facts is a belated attempt to stave off a judgment occasioned by its neglect in taking testimony."[17]

In its opposition to StonCor's motion to strike, Les Pierres argues that *Litton* is inapplicable because Les Pierres is not "attempting to rely on judicial notice of dictionary definitions to make a *prima facie* case in order to avoid judgment under 37 C.F.R. 2.132."[18] Neither the rules nor the case law recognize any such distinction. While the *Litton* Board based its decision in part on 37 C.F.R. 2.132, the crux of the decision was the Board's determination that taking judicial notice is proper only if the requesting party supplies the prerequisite notice of reliance under 37 C.F.R. 2.122(c).[19] The Board held that unless a party provides the notice during its testimony period as required, its opponent cannot address the judicially noticed fact during rebuttal. The Board further stated that a proper notice of reliance under 37 C.F.R.

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[13] 15 USC 1057, 1115
[14] *Litton Business Systems, Inc. v. J.G. Furniture Co.*, 190 USPQ 431, 432 (T.T.A.B. 1976).
[15] Id.
[16] Id.
[17] Id.
[18] Les Pierres opposition to StonCor's motion, pg. 2.
[19] Noting that 37 CFR 2.122(c) fulfills both requirements of Federal Rule of Evidence 201(d) regarding judicial notice, which requires a party both to serve notice of the request for judicial notice and to supply the requested information or materials.

2.122(c) avoids "the great loss of time that would be incurred if a party adverted to a fact to be judicially noticed for the first time in its brief at final hearing and the adverse party exercised its right to heard under Rule 201(e)."[20] This reasoning directly applies to Les Pierres, which chose to wait to present evidence until after its testimony period had passed.

The *Litton* Board stated that a party should not have to guess whether the opposing party was going to attempt to support its *prima facie* case with judicially noticed facts after its testimony period had ended. Such guessing would force the first party, namely the respondent in *Litton*, to put on potentially unnecessary testimony concerning the petitioner's next anticipated move during the respondent's testimony period; otherwise the respondent would be deprived of the opportunity to rebut.[21]

StonCor has already presented its *prima facie* case through timely introduction of the incontestable registrations of the StonCor family of marks. Les Pierres presented no evidence to refute StonCor's case. Les Pierres, like the plaintiff in *Litton*, is requesting the Board to take judicial notice of evidence purportedly supporting its only argument against StonCor, without having properly introduced the evidence during Les Pierres testimony period, so as to leave StonCor without an opportunity to rebut Les Pierres' only proffered evidence. As in *Litton*, StonCor would be severely and unjustly prejudiced if judicial notice is permitted now.

The Board reached a similar conclusion in *Sprague Electric Company*.[22] In *Sprague*, the Board found that the opposer's introduction of dictionary definitions during the rebuttal period was inappropriate because the definitions went to the heart of the opposer's claim and, "as such, should have been offered as part of its record-in-chief."[23] The Board noted that judicial notice

[20] *Litton Business Systems, Inc. v. J.G. Furniture Co.*, 190 USPQ 431, 432 (T.T.A.B. 1976).
[21] Id 433-434.
[22] *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (T.T.A.B .1980).
[23] Id.

may be taken of any "standard reference marks including dictionaries", but found that "the point to be made here is that the Board's attention was not called to these definitions until Sprague's rebuttal period."[24] Les Pierres, like the plaintiff in *Sprague*, is attempting, via the judicial notice route, to sneak in evidence that should have been offered as part of Les Pierres case-in-chief. The issue here, as in *Sprague*, is not the propriety of taking judicial notice of dictionary terms generally, but the impropriety of the Board taking judicial notice of evidence constituting a large part, if not all, of a party's case-in-chief, after the party's testimony period has closed.

Les Pierres is attempting to submit the only evidence (other than Les Pierres' application) supporting Les Pierres' position, after Les Pierres testimony period has passed, by improperly requesting judicial notice of evidence that should have been presented via notice of reliance during Les Pierres' testimony period. If the Board allows Les Pierres to circumvent the C.F.R. prescribed procedure for introduction of evidence, StonCor will be unfairly and unjustly prejudiced.

For all of these reasons, Les Pierres' objections to StonCor's motion lack merit. StonCor's motion to strike should be granted.

Respectfully submitted,

Date: 31 March 2010

/CHARLES N. QUINN/

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[24] Id.

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CERTIFICATE OF SERVICE

I, Charles N. Quinn, of full age, by way of certification, state that a copy of StonCor's Reply Brief was served on applicant's counsel on the date set forth below via first class mail, postage prepaid, addressed as follows:

James R. Menker, Esquire
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P. O. Box 331937
Atlantic Beach, FL 32202

Date: 31 March 2010

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